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In re Application of: :
JONES, David, H., A., et al. : DECISION ON RENEWED PETITION
Application No. 10/644,256 :
Filed: August 20, 2003 :
Attorney Docket No. 2578-6077US :
:

This is a decision on the renewed "Petition Under 37 CFR §1.78(a)(3) And 37 CFR § 1.78(a)(6) For Acceptance Of Unintentionally Delayed Priority Claims" filed August 21 2009, considered herein under 37 CFR 1.78(a)(3) and (a)(6) and 37 CFR 1.55(c).

For the reasons discussed below, the petition is **DISMISSED**.

1. Claims To Prior-Filed International And Provisional Applications

37 CFR 1.78(a)(3) applies where an applicant seeks to add a late claim of benefit under 35 U.S.C. 120 and 365(c) to a prior-filed international application designating the United States; 37 CFR 1.78(a)(6) applies where an applicant seeks to add a late claim of priority to a prior-filed provisional application. In the present petition, applicants are seeking to add domestic priority claims to two international applications (PCT/EP2003/007690 and PCT/EP03/50201) and to a U.S. provisional application (60/397,066). Accordingly, the present petition is properly considered under both 37 CFR 1.78(a)(3) and (a)(6).

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii) and 1.78(a)(5)(ii).

The present non-provisional application was filed after November 29, 2000, and the claims herein for the benefit of priority to the prior-filed applications were submitted after expiration of the periods specified in 37 CFR 1.78(a)(2)(ii) and 1.78(a)(5)(ii). Therefore, this is a proper petition under 37 CFR 1.78(a)(3) and 1.78(a)(6).

A grantable petition under 37 CFR 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

- (1) the reference required by 35 U.S.C. 120 and 119(e) and 37 CFR 1.78(a)(2)(i) and 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in 1.17(t); and

(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional.

As with the previous petition, the present petition fails to comply with item (1) above.

The present petition was accompanied by a revised amendment to the first paragraph of the specification that clarifies applicants' desired benefit claims. The reference is in acceptable form with respect to the claim to international application PCT/EP2003/007690 and, through such international application, to U.S. provisional application 60/397,066. However, the reference with respect to purported international application PCT/EP03/50201 is not acceptable on the present record. Specifically, PCT/EP03/50201 does not appear to have ever been published by the International Bureau (IB). It therefore appears that such application was withdrawn by applicants at some point prior to publication. Applicants have not provided a copy of PCT/EP03/50201 and certification (with documentary support) confirming that such application was not withdrawn prior to the filing of the present application and that it named at least one inventor in common with the present application. Accordingly, it cannot be confirmed on the present record whether the benefit claim directed to this international application is correct and appropriate. See MPEP section 1895.01:

a national application filed prior to the expiration of this 30 month period will be copending with the international application unless the international application was withdrawn, either generally or as to the United States, prior to the filing of the national application.

To determine whether the application was withdrawn, the examiner must either review the Home Copy of the international application file (if the USPTO was the receiving Office), or require applicant to certify that the international application was not withdrawn or considered to be withdrawn, either generally or as to the United States, prior to the filing date of the national application claiming benefit under 35 U.S.C. 120 and 365(c) to such international application.

Before the petition under 37 CFR 1.78(a)(3) and (a)(6) can be granted, a renewed petition under 37 CFR 1.78(a)(3) and a substitute amendment¹ or supplemental ADS (37 CFR 1.76) containing proper references to the prior-filed international and provisional applications is required. If any such renewed petition includes a benefit claim directed to international application PCT/EP03/50201, applicants must provide a copy of PCT/EP03/50201 and certification (with documentary support) confirming that such application was not withdrawn prior to the filing of the present application and that it named at least one inventor in common with the present application.

¹ Note 37 CFR 1.121

2. **Claim To Prior-Filed Foreign Application EP 02077953.4**

The present petition again requests the addition of a priority claim directed to foreign application EP 02077953.4, filed on July 18, 2002, although the claim is inaccurately characterized as a domestic priority claim under 35 U.S.C. 365(c). 35 U.S.C. 365(c) states that an international application designating the United States may claim domestic priority under 35 U.S.C. 120 with respect to a prior national application or a prior international application designating the United States, and that a national application may claim domestic priority under 35 U.S.C. 120 with respect to a prior international application designating the United States. 35 U.S.C. 365(c) does not apply where, as here, a national application (or an international application designating the United States) seeks to claim the benefit of the filing date of a prior filed foreign application. Rather, applicant's claim for foreign priority with respect to EP 02077953.4 is properly made under 35 U.S.C. 119(a)-(d) and 365(b). It is noted that the declaration filed by applicant on 20 November 2006 includes a claim of foreign priority with respect to EP 02077953 properly made under 35 U.S.C. 119(a)-(d) and 365(b). However, because this claim of foreign priority was not submitted within four months of the filing of the present application, a grantable petition under 37 CFR 1.55(c) is required to add this foreign priority claim.

A grantable petition under 37 CFR 1.55(c) to accept an unintentionally delayed claim for priority requires:

- (1) The nonprovisional application claiming the benefit of an earlier filing date must be filed on or after November 29, 2000;
- (2) the claim submitted with the petition must identify the prior foreign application for which priority is claimed, as well as any foreign application for the same subject matter and having a filing date before that of the application for which priority is claimed, by the application number, country, and the filing date, and be included either in an oath or declaration (37 CFR 1.63(c)(2)) or in an Application Data Sheet (37 CFR 1.76(b)(6));
- (3) the surcharge as set forth in 37 CFR 1.17(t);
- (4) a statement that the entire delay between the date the claim was due under 37 CFR 1.55(a)(1) and the date the claim was filed was unintentional. (The Commissioner may require additional information where there is a question whether the delay was unintentional.); and
- (5) the above-identified nonprovisional application must be filed within 12 months of the filing date of the foreign application.

The present application was filed after November 29, 2000, satisfying item (1), and, as noted above, the declaration filed on 20 November 2006 includes a proper claim directed to the foreign application, satisfying item (2). Applicant has also paid the required petition fee, satisfying item (3), and the present petition includes an acceptable statement of unintentional delay, satisfying item (4). However, on the present record, item (5) above is not satisfied. Specifically, the filing date for the present application (August 20, 2003) is not within 12 months

of the filing date of EP 02077953.4 (July 18, 2002). It is noted that, should a renewed petition successfully add applicant's desired claim of domestic priority to prior filed international application PCT/EP2003/007690 or PCT/EP03/50201, then this final element of a grantable petition under 37 CFR 1.55(c) would be considered satisfied, in that the filing date of the intermediate PCT application would be within 12 months of the filing date of the foreign application.

Based on the above, applicants' renewed petition to add benefit claims directed to international applications PCT/EP2003/007690 and PCT/EP03/50201, European Patent Application No. 02077953.4, and U.S. provisional application 60/397,066 is not grantable on the present record.

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